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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,466	07/18/2003	Horst Knoetig	40424-189156	1148
26694	7590	06/20/2005		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998				EXAMINER PETERSON, KENNETH E
				ART UNIT 3724
				PAPER NUMBER

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/621,466	KNOETIG, HORST
	Examiner Kenneth E. Peterson	Art Unit 3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
 - 4a) Of the above claim(s) 4, 7 and 8 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3, 5, 6 and 9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

1. Applicant has indicated that claim 6 reads on the elected species. Examiner agrees to examine this. Since Applicant had not previously indicated this claim to be drawn to the elected species, it will be treated as an added claim, and subject to final rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,3,5,6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Detterman, et al.'780, who shows a book notcher with an acutely angled blade as seen in figure 9.

4. Claims 1,2,3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraushaar '757, who shows a cutter with an inwardly angled blade and an outwardly angled blade as seen in figure 3. Altho Kraushaar does not disclose notching books, a book placed in the device would undoubtedly get notched, and thus Kraushaar passes the *capability* test.

5. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Blake '928, who shows a transporter 20 and a book notcher with an acutely angled blade as seen in figures 1 and 2.

6. Made of record but not relied on are two pertinent book-notching patents to Fogg and Geiser.

7. Applicant's arguments have been fully considered but they are not persuasive.

Applicant has overcome the objection to claim 5.

Examiner notes that the phrase "a notching tool that rotates around a pivot, positioned approximately perpendicularly to the book block spine", as recited in claims 1 and 5, is a poor choice of words, since the elected species is clearly not perpendicular. The end of claim 5, in particular, highlights this point.

Applicant argues that Detterman's cutting teeth are not "positioned on opposite sides of the carrier". This is incorrect. As seen in figure 8, there are teeth on opposite sides of the carrier. If one were to draw a line dividing the carrier into two halves, there would always be at least one tooth on each opposite side. One thing that Applicant could do to overcome Detterman is add a recitation that "a straight line bisecting the pivot of the carrier would also cross two teeth on opposite sides of the carrier".

Applicant argues that Detterman does not disclose teeth on opposite sides "working" with each other to notch a book. Nonetheless, Detterman shows the structure and is capable of performing the function, depending on book size and other factors.

Applicant argues that Detterman's teeth are not acutely angled to the carrier plate. Applicant is incorrect. See figure 9. Furthermore, since the pivot 50 is angled and the notches are perpendicular to the spine, the blades *must* be acutely angled.

Applicant argues that Detterman is not making arcuate cuts. However, any rotating blades of this type intrinsically makes arcuate cuts. For examples of this, see the patents to Geiser and Blake. Detterman's arcuate cuts may not be as curvy as Applicant's are, but they are arcuate nonetheless.

Applicant argues that Kraushaar's cutter would not "produce arc shaped notches" in a book spine. However, if one placed a book, spine-first, into Kraushaar's receptacle (a), it would get notched. If one took that same book and again placed it, spine-first, into the receptacle, then it would get notched again. The notches would be "arc-shaped" due to the arcuate rotation of the blades. Again, the arcuate cuts may not be as curvy as Applicant's are, but they are arcuate nonetheless. One easy way to overcome this rejection is to change the functional language in the claims to "to produce arc-shaped notches spaced along the spine of the book".

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kp
16-Jun-05


KENNETH E. PETERSON
PRIMARY EXAMINER